

REMARKS

In the Office Action¹, the Examiner:

rejected claim 19 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 5,936,548 to Takatsuka ("Takatsuka") in view of U.S. Patent 6,778,069 to Katagiri ("Katagiri"); and

rejected claims 1, 4-6, 9, 11, 13-17, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over Takatsuka, in view of Katagiri, further in view of U.S. Patent 7,281,215 to Canfield et al. ("Canfield").

By this amendment, Applicant amends claims 1, 4, 9, 11, 13, 14, 16, 17, 19-21, and adds new claims 22-28. No new matter has been added, as support for the amendments and new claims can be found at, for example, p. 5, ll. 18-30, and at least Figure 4 of Applicant's specification. Claims 1, 4-6, 9, 11, 13-17, and 19-28 are thus pending.

I. The rejection of claim 19 under 35 U.S.C. §103(a)

Applicant respectfully traverses the rejection of claim 19 under 35 U.S.C. § 103(a) as unpatentable over Takatsuka and Katagiri.

Independent claim 19, as amended, recites:

redisplaying the home screen with the first indicator on the visual display, following display of the message listing, and while at least one electronic message is in the unopened state; and

providing a second indicator at the location on the home screen, reflecting that a number of new unopened electronic messages have been received, the second indicator distinguishing the new unopened electronic messages from

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

the at least one electronic message in the unopened state
represented by the first indicator

(emphasis added). Takatsuka and Katagiri, taken alone or in any combination, fail to teach or suggest at least these claimed steps of amended independent claim 19.

Takatsuka discloses a message system where a display "displays the total message number and presence or absence of the non-read message per directory." Takatsuka, col. 5, ll. 15-16. Furthermore, a list display is provided in Takatsuka, where "a portion of the message, receiving date and time, whether or not the message is non-read, and a message sender [is displayed]." Takatsuka, col. 5, ll. 45-47. However, Takatsuka explicitly discloses that a user must open and read an unread message to clear the "non-read" status: "when the user selects the message using the scroll switch . . . and pushes the execution switch 45, the operating section 40 produces a first one of the command signals. Responsive to the first one of the command signals, the control section 20 controls the LCD driver 51 to display the selected message on the display unit 52." Takatsuka, col. 5, ll. 54-60. "Simultaneously, the control section 20 erases the non-read flag of the readout message." Takatsuka, col. 5, ll. 62-64 (emphasis added).

Thus, Takatsuka clearly discloses that a user must read a message prior to erasing a non-read flag associated with the message, and if a user does not erase the non-read flag, there is no way to distinguish from a new incoming unread message from the previously received unread messages. Therefore, Takatsuka cannot disclose "redisplaying the home screen with the first indicator on the visual display, following display of the message listing, and while at least one electronic message is still in an unopened state[,] and providing a second indicator at the location on the home screen, reflecting that a number of new unopened electronic messages have been received, the

second indicator distinguishing the new unopened electronic messages from the at least one electronic message in the unopened state represented by the first indicator," as recited in amended claim 19.

Indeed, the Office concedes that Takatsuka "does not disclose providing a second indicator at the location on the home screen, reflecting the number of new unread electronic messages received following display of the message listing, as disclosed in the claims." Office Action at 49. The Office instead relies on Katagiri to remedy the deficiencies of Takatsuka. Such reliance, however, is improper, as Katagiri fails to cure the deficiencies of Takatsuka.

Katagiri discloses a "radio selective-paging system which is capable of easily recognizing the piece number of unread received messages available for the user among received messages" Katagiri, col. 1, l. 67 to col. 2, l. 3. In Katagiri, a controller "store[s] the received message in the message storing unit 3 and at the same time executes the control to display the received message on the screen of the display unit 4." Katagiri, col. 5, ll. 9-12 (emphasis added). The controller in Katagiri further controls an adder unit, and "[w]hen the user applies the already-read instruction operation to the operating unit 6, the adder unit 5 clears the counted value to zero, and then adds the piece number of the received messages after the already-read instruction operation for every attribute." Katagiri, col. 5, ll. 16-20.

Furthermore, Katagiri discloses that "a mark '.star.' indicating that the received message has not been read yet is displayed on the third line of the screen . . . [and] a numeral '1' which is the piece number of the unread received message[] counted by the adder unit 5 is displayed on the fourth line of the screen." Katagiri, col. 5, ll. 46-51.

"[W]hen the user applies the already-read instruction operation, which indicates that the received message being displayed on the screen **has been read by the user** . . . the mark '.star.' displayed on the third line to indicate that the receive message has not been read yet is cleared." Katagiri, col. 5, ll. 57-63 (emphasis added). That is, once the user reads an unread message, the star indicator is cleared, as exemplified in FIG. 2C and FIG. 2D. However, Katagiri also has no way of distinguishing "old" unread messages from "new" unread messages, as any new unread messages will not receive a distinguishing indicator from the star indicator already representing the "old" unread messages, unless the user reads one of the "old" unread messages.

Specifically, Katagiri explains with reference to FIG. 2C that ten messages are received, and the user has not read these messages, so the star indicator is provided. However, as noted with reference to FIG. 2D, the star indicator is cleared "since the user has input the already-read instruction operation, which indicates that the received message of "Vacant Seat Situation at a time 10:10 in the Theater 001 and the Theater 002" . . . has been read by the user . . . [and] the piece number of the unread received messages displayed on the fourth line is changed from "10" to "9." Katagiri, col. 6, ll. 8-15. At this point, Katagiri discloses that the other 9 unread messages are old and unnecessary. "Then, the ninth unread received message is older than the message "Vacant Seat Situation at a time 10:10 in the Theater 001 and the Theater 002", for example, and thus this message is the receive message unnecessary for the user." Katagiri, col. 6, ll. 16-19.

Thus, the star indicator is cleared upon reading a message, and since the other 9 messages are unnecessary for the user, Katagiri will only display "new" unread

message information when additional messages are received. As shown in FIG. 2E, "two new received messages are received after the screen displayed in FIG. 2D, and the mark 'star.' displayed on the third line to indicate that the received messages have not been read yet" Katagiri, col. 6, ll. 32-35. "Based on the screen display in FIG. 2E, the user can understand clearly that two unread messages received after the screen display in FIG. 2D should be read." Katagiri, col. 6, ll. 41-43.

Accordingly, Katagiri will only clear the star indicator once a user reads a message. Furthermore, as shown in FIG. 2E, when new unread messages are received, Katagiri will simply display the star indicator and will only display the number of new unread messages. However, Katagiri provides no ability to distinguish between electronic messages still in the unopened state, and newly received unread electronic messages. Therefore, Katagiri also cannot disclose "redisplaying the home screen with the first indicator on the visual display, following display of the message listing, and while at least one electronic message is still in an unopened state[,] and providing a second indicator at the location on the home screen, reflecting that a number of new unopened electronic messages have been received, the second indicator distinguishing the new unopened electronic messages from the at least one electronic message in the unopened state represented by the first indicator," as recited in amended claim 19.

Furthermore, the Office's proposed combination of Takatsuka and Katagiri is improper. The Office Action alleges that one of ordinary skill in the art:

would have been motivated to add providing a second indicator at the location on the home screen, reflecting the number of new unread electronic messages received following display of the message listing . . . because this adds further detail for the user to more completely understand the state of new unread messages . . . [t]his may

be useful **because the user may have scanned the current unread messages** for a particular message of interest and found that that message was not present and notifying the user of newer unread messages since the last can alert[] the user that the message of interest may be in the next set of unread messages."

Office Action at 51. However, such an allegation is a clear example of impermissible hindsight, as the alleged motivation of a user potentially "scanning" the current unread messages for particular messages and desiring an indication of newly received unread messages is not provided by any of the references, but rather is gleaned directly from Applicant's Specification, which details:

there are a significant number of recipients of electronic messages who do not regularly clean out their messages received because of the **sheer volume of messages** and/or the lack of time or inclination. Aspects of the invention help these people to manage their electronic messages received by **providing an indication that new electronic messages have been received since the user last scanned the message list**.

Applicant's Specification, p. 4, l. 28 to p. 5, l. 1 (emphases added). The alleged motivation even uses the same terminology found in Applicant's specification of a user having "scanned" the messages. Neither Takatsuka nor Katagiri provide any sort of suggestion that a user may be interested in "scanning" a message list, and one would not modify Takatsuka and Katagiri without resorting to using Applicant's specification as a blueprint for the rejection. Furthermore, Katagiri explicitly indicates that certain unread messages are considered obsolete and unnecessary for the user to read, as indicated in column 6, lines 16-19 of Katagiri. Therefore, a user would not be interested in obtaining more information for understanding the state of these unread messages, as proposed by the Office.

Accordingly, one of ordinary skill in the art would not look to combine Takatsuka and Katagiri in the manner suggested by the Office Action, and the proposed combination of Takatsuka and Katagiri is nothing more than impermissible hindsight reconstruction using Applicant's disclosure as a blueprint.

For at least the above reasons, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claim 19. Accordingly, the Office Action has not clearly articulated a reason as to why the claim would have been obvious to one of ordinary skill in view of the prior art. A *prima facie* case of obviousness has not been established for independent claim 19 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

II. **The rejection of claims 1, 4-6, 9, 11, 13-17, 20, and 21 under 35 U.S.C. §103(a)**

Applicant respectfully traverses the rejection of claims 1, 4-6, 9, 11, 13-17, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over Takatsuka, Katagiri, and Canfield. Amended independent claims 1, 4, 11, and 20, though of different scope from claim 19, recite features similar to those discussed above in connection with claim 34. Furthermore, Canfield fails to remedy the deficiencies of Takatsuka and Katagiri. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 4, 11, and 20 for at least similar reasons as independent claim 19, and the claims should therefore be allowed.

Furthermore, dependent claims 5, 6, 9, 13-17, and 21 depend from independent claims 4, 11, and 20, and because Takatsuka, Katagiri, and Canfield do not support the

rejection of independent claims 4, 11, and 20, under 35 U.S.C. § 103(a), Takatsuka, Katagiri, and Canfield also do not support the rejection of the dependent claims.

III. **Newly added claims 22-28**

For at least the above reasons, Takatsuka, Katagiri, and Canfield, taken individually or in combination, also fail to teach or suggest all the recitations of newly added claims 22-26. Additionally, newly added independent claim 27 recites "triggering the recently checked Boolean value to true when the message listing is displayed on the visual display and while the first electronic message is in the unopened state[,] wherein, following display of the message listing on the visual display, the recently checked Boolean value is triggered to false when a new unopened electronic message is received and the home screen is displayed on the visual display." Takatsuka, Katagiri, and Canfield fail to teach or suggest at least these elements of independent claim 27. Furthermore, newly added dependent claim 28 depends from independent claim 27, and is allowable at least in view of its dependence.

Accordingly, Applicant respectfully requests the timely allowance of claims 22-28.

CONCLUSION


In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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